

REMARKS

The present remarks are in response to the Office Action of February 23, 2006. Claims 1- 22 are currently pending.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, the Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following rejections and objection were issued:

- (1) Claims 1-5, 7-8, 11-15, 17-18, and 21 were rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Pat. No. 5,286,061 (hereinafter "Behm");
- (2) Claims 9-10 and 19-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Behm in view of U.S. Pat. No. 4,198,445 (hereinafter "Sokol"); and
- (3) Claims 6, 16, and 22 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-5, 7-8, 11-15, 17-18, and 21 as being anticipated by Behm. Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson*

v. Suzuki Motor Co. 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). As the Examiner has rejected all three independent claims by Behm, a discussion of this reference is provided.

Behm

Behm discloses a method of enhancing the security of instant lottery tickets using validation data. See col. 4, lines 22-25. The validation data consists of invisible ink rendered visible by a developing agent. See col. 4, lines 25-27. The validation data consists of invisible validation instructions, such as "PAY \$5.00," which can replace the conventional human readable validation codes. See col. 5, lines 51-55. The validation data is printed in the play area along with the play indicia and the validation number. See col. 6, lines 60-64.

Claims 1, 11, and 21

Independent claims 1, 11, and 21 have been amended. All three of these claims require that the first invisible image be associated with a first visible image and that, upon be rendered visible, the second visible image modify the first visible image. The Examiner alleges that Behm discloses that "the invisible image [is] associated with the first visible image." See Office Action, page 2. In fact, Behm never requires that the validation data be associated with any other image. Behm simply states that the validation data is printed on the ticket in the play area, which is covered by an opaque layer. See col. 6, lines 58-64. The validation data is provided to enhance security and simply validates winning tickets. The validation data stands alone and does not require the presence of any other images to perform its intended purpose, as opposed to the present invention, which requires that the invisible image be associated with the first visible image so that, after becoming visible, it modifies the first visible image. The amended claims are clearly distinct over Behm since they require an association that modifies the first visible image. There are many examples of this in the specification including: highlight, solid underline, dotted underline, solid double underline, broken-line underline, bullet point, subscript, superscript, strikethrough, double strikethrough, shadow, outline, and graphic. See page 8, lines 17-20.

As Behm does not contain each and every element of the three independent claims, or associated dependent claims, the Applicants respectfully request that the Examiner withdraw this rejection.

Rejections under 35 U.S.C. 103

The Examiner has rejected claims 9-10 and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Behm in view of Sokol. The Applicants do not deem it necessary to recite the entire case law standard required in order to establish a *prima facie* case of obviousness. However, the Applicants, would like to briefly remind the Examiner of the required three criteria for a *prima facie* case of obviousness, namely that the asserted references as modified or combined must: 1) teach or suggest each and every element of the claimed invention; 2) provide sufficient motivation for the modification or combination asserted; and 3) provide a sufficient likelihood of successfully making the modification or combination.

Emphasis on the three independent claims is provided herein, as the Applicants assert that these claims are all patentably distinct over the prior art. As the Examiner has rejected the three independent claims over Behm in view of Sokol, and as Sokol has not been discussed, a brief discussion of Sokol is provided.

Sokol

Sokol discloses a method of rendering an invisible ink composition, containing phenolphthalein, temporarily visible. See col. 2. lines 25- 30, 54-60. The purpose of obtaining temporary visible images is related to teaching aids and self-instructional material. See col. 1, lines 8-13.

Claims 1, 11, and 21

Independent claims 1, 11, and 21 have been amended. All three of these claims require that the first invisible image be associated with a first visible image and that, upon be rendered visible, the second visible image modify the first visible image. The Applicants renew the arguments made above with respect to Behm. The Applicants stress that Sokol does not cure Behm's deficiencies. Sokol does not teach the use of a first

visible image with an associated second invisible image that, when made visible, modifies the first visible image.

Additionally, the combination of Behm with Sokol is improper. Behm teaches the uses of invisible validation data to enhance security of a lottery ticket while Sokol teaches the use of temporary visible ink for use in instructional or educational materials. Where is the motivation to combine these two references? Clearly the objectives of the references themselves do not relate to one another. Furthermore, there is nothing in Behm that suggests the use of phenolphthalein as a developable colorant. In fact, Behm specifically states that the image is preferable irreversible and permanent. See col. 8 lines 17-20. As Sokol teaches a reversible temporary image, this directly conflicts with Behm. Sokol teaches away from Behm. The combination of these two references would not have a likelihood of success given these conflicting teachings.

The Applicants assert that the combination of these references is improper, that such a combination could only be made with impermissible hindsight, and that such a combination has no likelihood of successfully producing the present invention. Additionally, since neither Behm nor Sokol teach all the elements of the three independent claims, and subsequent dependent claims, the Applicants respectfully request that this rejection be withdrawn.

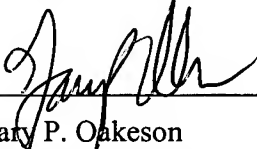
CONCLUSION

In view of the foregoing, Applicants believe that claims 1-22 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond at (541) 715-0159, or the undersigned attorney, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 19th day of May, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gary P. Oakeson", is written over a horizontal line.

Gary P. Oakeson
Attorney for Applicant
Registration No. 44,266

THORPE NORTH & WESTERN, LLP
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633

On Behalf Of:
HEWLETT-PACKARD COMPANY
1000 NE Circle Blvd., m/s 422B
Corvallis, OR 97330-4239
(541) 715-0159